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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,259	05/11/2001	Andrew Tibbs	18360/206856	5032
826	7590	09/20/2005	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			BASS, JON M	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/853,259	TIBBS ET AL.	
	Examiner	Art Unit	
	Jon Bass	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

***DETAILED ACTION***

1. This is in response to the communication "Method and System for generating and transmitting shipping labels". Claims 1-20 are pending in this application.

***Information Disclosure Statement***

2. An initialed and dated copy of Applicant's IDS form 1449 is attached to the instant Office action.
3. Applicant's claim for the benefit of an earlier filing date is acknowledged.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 1-20 are** rejected under 35 U.S.C. 101 because the invention as claimed is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

5. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. A claim limited to a machine or manufacture that has practical application in the technological arts is statutory. In most cases, a claim to a specific machine or manufacture will have practical application in the technological arts. See MPEP 2106, 2100-14 (quoting *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557). Additionally, for subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. See *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970).

6. In the present case, claim 1-20 only recites an abstract idea. The recited steps of, obtaining information and then providing electronic return to the customer, does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to request the returning of goods.
7. As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of

manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above.

Looking at the claim as a whole, nothing in the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps.

8. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. An invention, which is eligible or patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “use, concrete and tangible result”. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452 and *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998). The test for practical application as applied by the examiner involves the determination of the following factors”
  - (a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:
    - i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

9. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-20 is deemed to be directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1-20 are** rejected under 35 U.S.C. 102(e) as being anticipated by Daniel Williams et al (US Pub No: 2002/0032612 A1) hereinafter referenced as Williams.

**As Per Claim 1:**

Williams discloses a method for a merchant, [{fig 1, 2a}, merchant] to provide an electronic return shipping label to a customer to allow said customer to return goods, comprising the steps of, [{fig 6}, log on screen in an embodiment of the return system]:

receiving a return request for said goods from said customer, [{fig 7}, Return System Page];

obtaining shipping information related to said return request, [{fig 7}, Return System Page]; and

electronically providing said customer with said return shipping label that can be printed and affixed to a package for returning said goods, [{fig 6}, log on screen in an embodiment of

the return system].

**As Per Claim 2:**

Williams discloses a method wherein receiving a return request for said goods from said customer comprises said customer submitting said return request through a merchant website, [{fig 5e, 21m-21r}, web server] associated with a merchant server, [{fig 2, 20a}, system server].

**As Per Claims 3, 13 and 14:**

Williams discloses a method wherein receiving a return request for said goods from said customer comprises said customer contacting a representative of said merchant and said representative submitting said return request through a merchant website associated with a merchant server, [{fig 6}, Log on Screen in an embodiment of the Return System].

**As Per Claim 4:**

Williams discloses a method wherein said shipping information, [{fig 3b, 1215}, shipping station] related to said return request comprises a customer address and information, [{fig 6, 120} and {fig 8, 145} and {fig 10}; customers information and users name and return centers information] related to the size and weight, [{fig 2, 1024}, scale] of said goods that are being returned,

**As Per Claims 5 and 15:**

Williams discloses a method wherein at least a portion of said shipping information



related, [{fig 12}, return shipping Options Screen] to said return request is obtained from a customer order database, [{fig 3a, 22, 28-30}, database].

**As Per Claims 6 and 16:**

Williams discloses a method wherein at least a portion of said shipping information related, [{fig 12}, return shipping Options Screen] to said return request is obtained from a product database [{fig 3a, 22, 28-30}, database].

**As Per Claims 7 and 17:**

Williams discloses a method wherein said electronic return shipping label is formatted as an HTML document, [{fig 13j-1} web page link and {fig 27b}, HTML image size].

**As Per Claims 8 and 18:**

Williams discloses a method wherein electronically providing said customer with said return shipping label that can be printed and affixed to a package for returning said goods, [{fig 7}, Return System home page] comprises providing said customer with a URL address that corresponds to said return shipping label, [{fig 27a, 450}, tracking number].

**As Per Claims 9 and 19:**

Williams discloses a method wherein electronically providing said customer with said return shipping label that can be printed and affixed to a package for returning said goods, [{fig 7}, Return System home page] comprises providing said customer with a file containing an

electronic image of said return shipping label, [{0278} determine the Image Size].

**As Per Claim 10:**

Williams discloses a method further comprising the step of said merchant authorizing said return request, [{fig 25}, Merchant Main Menu Choices].

**As Per Claim 11:**

Williams discloses a method wherein electronically providing said customer with said return shipping label comprises sending said return shipping label to a carrier with instructions to pick up said goods from said customer, [{fig 3a}, carriers service].

**As Per Claim 12:**

Williams discloses a method for a merchant, [{fig 1, 2a} merchant] to provide an electronic return shipping label to a customer to allow said customer to return goods, comprising the steps of, [{fig 6}, log on screen in an embodiment of the return system]:

receiving a return request for said goods from said customer, Return System Page];

obtaining shipping information related to said return request, [{fig 7}, Return System Page];

transmitting said shipping information to an application service provider, [{fig 5b, 768, 21m-21r, 20a-20n} , return page, web server, database servers], said application service provider configured to process said shipping information and generate said return shipping label, [{fig 7}, return system home page];

generating said return shipping label at said application service provider, , [{fig 27b, 1254}], generate the label on the server]; and

providing said customer electronic access to said return shipping label, [{fig 27b, 1254}], generate the label on the server].

**As Per Claim 20:**

Williams discloses a system for a merchant to electronically provide a return shipping label to a customer that wishes to return goods, comprising, [{fig 6}, log on screen in an embodiment of the return system]:

a merchant server, hosting a merchant website and capable of communicating with an application service provider server and at least one customer computer, [{fig 3a, 8n}, buyers computer];

an application service provider server in communication with said merchant server, [{fig 3a, 8a, 8n}, sellers computer, buyer computer];

an application service provider application, residing on said application service provider server configured to generate said return shipping label based at least on part on shipping information received from said merchant server, [{fig 27b, 1254}], generate label]; and

a customer computer for receiving said return shipping label, [{fig 3a, 8n}, buyers computer].

***Conclusion***

Any concerns in regard to this communication, the examiner **Jon Bass** can be reached at

(571) 272-6905 between the hours of 9-6pm Monday through Friday. The fax number for the establishment where the application is being process is (571) 273-8300.

If an attempt to reach the examiner is unsuccessful for any reason, the examiner's immediate supervisor, **John Hayes** can be reached at (571) 272-6708.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished is available through Private PAIR only. For more information about the PAIR system, see [http:// pair-direct.uspto.gov](http://pair-direct.uspto.gov). Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-271-9197 (toll free).

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

C/O Technology Center 3600

Washington, D.C. 20231

  
JOHN W. HAYES  
PRIMARY EXAMINER

